

PATENT  
514429-3647.1**REMARKS**

The Office Action required an election under 35 U.S.C. § 121 from among:

- Group I: Claims 1-5 and 11, drawn to a semaphorin protein, classified in class 530, subclass 300;
- Group II: Claims 6-10 and 12-18, drawn to isolated nucleic acid, their expression vectors and cells comprising the vector, and method of making a protein of Group I, classified in class 536, subclass 23.1 and class 935, subclass 66;
- Group III: Claim 19, drawn to method of making a nucleic acid, classified in class 435, subclass 92.1;
- Group IV: Claim 22 (in part), drawn to an antibody recognizing fragment 179-378 of polypeptide SEQ ID No. 3, classified in class 530, subclass 388.1;
- Group V: Claim 22 (in part), drawn to an antibody recognizing fragment 480-666 of polypeptide SEQ ID No. 3, classified in class 530, subclass 388.1;
- Group VI: Claim 22 (in part), drawn to a method of making an antibody to any semaphorin protein, classified in class 424, subclass 130.1;
- Group VII: Claim 20, drawn to peptide-based methods of screening, classified in class 435, subclass 7.1;
- Group VIII: Claims 24 and 27 drawn to method of treating immunological disorder using polypeptide, classified in class 514, subclass 02;
- Group IX: Claims 25, 26 and 28 drawn to method of treating immunological disorder using polynucleotides, classified in class 514, subclass 44; and
- Group X: Claim 29, drawn to method of inhibiting inflammation by introducing nucleic acid into a cell, classified in class 424, subclass 93.1.

The Office Action further required an election of species. The invention of Group I, claims 1-5 and 11, SEQ ID No. 3 and an unmodified polypeptide are elected, with traverse, for further prosecution in this application. Reconsideration and withdrawal of the restriction and species election requirements are respectfully requested in view of the remarks herewith.

PATENT  
514429-3647.1

Under Patent Office procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP 803 (emphasis added).

Applicants respectfully submit that the groups of claims designated by the Examiner fail to define compositions and methods for using such compositions with properties so distinct as to warrant separate examination and search. In particular, with respect to the claims of Groups I and II, the Examiner admits that "...various processing steps may cause a polypeptide of Group I to be directed as to its synthesis by a polynucleotide of Group II. In addition, it is admitted in the Office Action that polypeptides are not always separately characterized and published in the biochemical literature from nucleic acid molecules that encode them. Finally, in making this requirement, the Office Action asserts that the claims of Groups I and II are distinct because "processing that may connect two groups does not prevent them from being viewed as distinct, because enough processing can result in producing any composition from any other composition if the processing is not limited to additions, subtractions, enzyme actions, etc." Yet, the Office Action does not provide any evidence to support this blanket assertion. Thus, contrary to the statements in the Office Action, the conjoint examination of the claims of Groups I and II does not place an undue burden on the Examiner.

Moreover, numerous admissions are made throughout the restriction requirement that many of the groups of claims are related. Hence, assertions to the contrary notwithstanding, Applicants respectfully submit the conjoint examination and inclusion of all the claims of the present application, or at least the modification to permit the conjoint examination of the claims of Groups I and II would not present an undue burden on the Examiner.

The results of the present restriction and election of species requirements are inefficiencies and unnecessary expenditures by both the Applicants and the PTO and extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed); and restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claims of all groups and species. Indeed, the search and examination of each Group and species is likely to be co-extensive and, in any event, would involve such

PATENT  
514429-3647.1

interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding remarks, therefore, mitigate against restriction.

Accordingly, withdrawal of the entire requirement for restriction, or at least revision of the requirement to permit the conjoint examination of at least the claims of Groups I and II is respectfully requested.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

By: 

THOMAS J. KOWALSKI  
Reg. No. 32,147  
(212) 588-0800